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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,191	12/06/2000	Alberto Lee Bigio	6772-1 CIP	8589

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EXAMINER

SPISICH, MARK

ART UNIT	PAPER NUMBER
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1744

DATE MAILED: 07/07/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/731,191

Applicant(s)

BIGIO, ALBERTO LEE

Examiner

Mark Spisich

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Comment Re Claim 9

The original claims in this application (claims 1-8) were specifically drawn to the embodiment which included bristles of **various lengths** (emphasis added) and wherein the bristle ends defined **one of a cylindrical shape and an arcuate segment of a cylindrical shape** (emphasis added). These limitations thus excluded the embodiment which defined the hourglass shape and this obviated any double-patenting rejection. New claim 9 is specifically drawn to the embodiment claimed in the parent application (09/451,747).

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 9 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,2 and 4-7 of copending Application No. 09/451,747. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations recited in the

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claims of the co-pending (as of the date of this office action) application would anticipate those of newly presented claim 9 and that any differences between the claims are merely obvious differences in wording.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by UK 17,666. '666 discloses, in the embodiment of fig 6a, a brush comprising an elongated handle segment and a bristle substrate on a common axial centerline, the bristle substrate defining a cylindrical core segment with a smoothly curved concave central region and radially larger end regions and a plurality of bristles of various lengths such that they define a cylindrical shape (again see fig 6a as well as page 4, lines 26-28). The added language added to claim 1 pertains solely to the intended use of the brush and fails to structurally define over the prior art.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over UK 17,666 in view of Tobias (USP D424,303). Although '666 would seem to at least suggest the bristle bundle arrangement of claim 2, the patent to Tobias is further cited to show a brush of the type of '666 which discloses the recited bristle bundle row arrangement of claim 2. It would have been obvious to one of ordinary skill to have modified the brush of '666 as it is shown by the prior art to be a known bristle arrangement. '666 discloses numerous handle shapes, including a cylindrical shape (claim 3) with a continuously curved convex having radially smaller handle end regions (claim 4) (see fig 8a). One of ordinary skill would deem it obvious to utilize any of the handles of '666 based on user preference.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over UK 17,666 in view of Flom (USP 3,691,585). '666 discloses the invention substantially as claimed with the exception of the "individual" bristles. Although it is not as common in the art of toothbrushes, it is nonetheless known to use "individual" bristles on a toothbrush as in taught by the patent to Flom. It would have been obvious to one of ordinary skill to have modified the prior art as such so as to reduce a manufacturing step.

8. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over UK 17,666 in view of Tobias (USP D424,303). Claim 9 is similar to claim 1n but it instead recites that the bristles define an hourglass shaped bristle system. Fig 8a of '666 discloses a brush comprising an elongated member divided into an elongated handle

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segment as well as an elongated bristle segment aligned therewith which has an hourglass shape with a core segment with a radially smaller central region and progressively large end regions and further comprising bristles attached over the bristle substrate with the bristles being substantially equal length such that the hourglass shape of the bristle substrate is transferred to the surface defined by the free ends of the bristles. The recitation of the intended use (by virtue of the recitation of "hair brush bristles") defines no structure. Merely reciting that a bristle is a hair brush bristle is only a recitation of the intended use of the device and not a structural limitation. '666 does disclose that the bristles are segregated into small bundles (as is well known in the art) as illustrated in figures 1-5; however, it fails to disclose the particular bristle row arrangement. The patent to Tobias has been cited to show, in a brush of the type of '666, bristle bundles "arranged in a series of axially aligned and radially distributed linear bristle rows" wherein adjacent rows are spaced from each other as well as the bundles within each row. It would have been obvious to one of ordinary skill to have modified the brush of '666 as taught by Tobias as it is a well known manner of arranging bristle bundles on an arcuate brush head.

Response to Arguments

9. Applicant's arguments filed 2 June 2003 have been fully considered but they are not persuasive. The alleged deficiencies of the prior art (especially in view of UK 17,666) still pertain to the intended use of the brush. Every element of the claim(s) is met by the prior art. The brush of '666 COULD be brushed across the hair of a person. Differences in the mode of operation between the claimed brush and that of the prior art

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are the realm of a method claim(s). A device which possesses all of the elements of the claimed device cannot be termed non-analogous. Any structural differences which the disclosed brush of the present invention may possess with regard to the prior art are NOT claimed in any of the pending claims.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Spisich whose telephone number is (703) 308-1271. The examiner can normally be reached on M-Th (6-3:30), Alternate Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert J Warden can be reached on (703) 308-2920. The fax phone numbers for the organization where this application or proceeding is assigned are (703)

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872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "Mark Spisich", with a long horizontal flourish extending to the right.

Mark Spisich
Primary Examiner
Art Unit 1744

MS
July 7, 2003